

Appl. No. : 09/493,794
Filed : January 28, 2000

REMARKS

These amendments and remarks are responsive to the Office Action mailed on April 23, 2007.

Status of Amendments

Although an Amendment and Response was filed on August 28, 2006, the Examiner's response in the April 23, 2007 Office Action leads the Applicants to believe that the amendments were not entered. The Office Action of 4/23/2007 is identical in every respect to the Office Action mailed on February 28, 2006 and makes no acknowledgement at all of Applicant's response filed on August 28, 2006. In fact, the Office Action Summary still states that it is responsive to a communication filed on "121/08/05 [sic]." Accordingly, Applicants assume that Applicant's prior amendments were not entered.

Hence, the previously presented amendments are re-submitted in this paper anew and such amendments are labeled "Currently amended" in light of Examiner's April 23, 2007 Office Action which fails to acknowledge Applicant's August 28, 2006 Response. Claims 11-25 and 31-34 are cancelled without prejudice (as was done in the August 28, 2006 Response), and Claims 1, 4-7, 9, and 10 are amended to more explicitly claim a structure (again, as was done in the August 28, 2006 Response). Claims 1-10 are therefore presented for further consideration.

Claim Rejections based on 35 U.S.C. § 112

The Examiner rejects Claims 1-10 under 35 U.S.C. § 112 as being indefinite for including the limitations of a method when the preamble indicates a product. However, the Applicant respectfully submits that in the previous response, filed August 28, 2006, Applicant amended the claims to clearly claim a structure. The Applicant submitted, in the prior response, that the § 112 rejection was overcome in light of those amendments. However, in the April 23, 2007 Office Action, the Examiner appears to have failed to give these amendments any consideration and simply repeats the same § 112 rejection. This leads the Applicant to believe that the prior amendments were not entered. Hence, the amendments are re-submitted as if new.

As Applicant noted in the previous response,

a structure can be limited by recitation of its function. *In re Bernhart*, 163 U.S.P.Q. 611, 615-16 (CCPA 1969) (“If a machine is programmed in a certain new and unobvious way, it is *physically [sic]* different from the machine without that program...”). As noted in the application, “the embodiments as described above may be implemented in many different embodiments of software, firmware, and hardware in the entities illustrated in the figures.... a person of ordinary skill in the art would be able to design software and control hardware to implement the embodiments based on the description herein.” Application as filed at p. 21, lines 11-19.

Claim Rejections based on 35 U.S.C. §§ 102 & 103

As noted above, the Applicant believes that the Examiner did not take notice of the response filed August 28, 2006, since the Examiner repeats the rejection of Claims 1-10 “under 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Press Release of 1999” in the April 23, 2007 Office Action, making no reference to the Applicant’s previous response. As noted previously, the Applicant respectfully submits that

the reference [Press Release of 1999] fails to teach each and every feature of the claims, and so fails to provide a *prima facie* case of anticipation. As noted in the prior response, dated November 19, 2001, the ChemConnect press release discloses only use of “an open, neutral market for chemical manufacturers, buyers and intermediaries to conduct real-time, online transactions for all types of chemicals.” The ChemConnect press release fails to disclose each and every feature of the system in Claim 1, including the recited network, clearinghouse computer server, web browser, enterprise resource planning system and translation server.

Note that Claim 1 as amended recites, among other things, a translation server “configured to convert data in a format of the

enterprise resource planning system into a converted format of the clearinghouse computer server." As explained in the application as filed, this translation server addresses use of incompatible data formats by members of the clearinghouse mechanism.

The entirety of what could remotely be considered relevant in the Press Release follows:

SAN FRANCISCO, August 9, 1999: ChemConnect, Inc. (WNW.chemconnect.com), the largest global Internet exchange for all types of chemicals, today announced a successful second round of capital funding totaling \$30 million. Co-leads were Weiss, Peck & Greer and Goldman Sachs. Christopher J. Schaepe, a general partner of Weiss, Peck & Greer, will also join the ChemConnect Board of Directors to represent the new investors. ChemConnect's original capital partner, Institutional Venture Partners (IVP), also participated, as did Chemical and Materials Enterprise Associates (CMEA) Ventures and Highland Capital Ventures.

These industry-leading investment firms agree that ChemConnect brings a new, dynamic e-commerce model to the chemical industry.

"To date, chemical electronic marketplaces have solely focused on a narrow segment of the overall chemical market such as petrochemicals or research chemicals. The methods for selling and purchasing these chemicals have also been limited to fixed-price online catalogs, distributors' web sites, or private clubs that require special membership fees," said Christopher J. Schaepe of Weiss, Peck & Greer Venture Partners. "We believe that ChemConnect is the category leader of the next generation of e-commerce for the chemical industry. ChemConnect's World Chemical Exchange is a true exchange with dynamic pricing driven by the global market of many buyers and sellers."

"Chemical companies recognize the tremendous value of e-commerce and are exploring new and innovative ways to leverage the Internet to expand their reach," said Randy Blumenthal, vice president, Goldman Sachs. "ChemConnect's vision of a global, online trading community complements the purchasing and distribution strategies of both chemical buyers and sellers all of whom can benefit from a world market where a wide variety of chemicals can always be found."

"Increased market competition and the drive to cut overall costs create the need for the kind of efficiencies that a realtime, global chemical marketplace can provide," said Thomas R Baruch, CMEA Ventures' founder and general partner. "ChemConnect's integrated system of electronic commerce is uniquely suited to substantially reduce transaction costs for the chemical value chain.

The Company also has the right combination of domain expertise, logistics knowledge, product diversity and business infrastructure to be the premier exchange for the entire industry."

Today, ChemConnect is the world's largest Internet chemical exchange with over 10,000 users. The Company provides an open, neutral market for chemical manufacturers, buyers and intermediaries to conduct real-time, online transactions for all types of chemicals. In addition to hosting billions of dollars in transactions, ChemConnect also provides industry news and information to thousands of customers worldwide. "With the backing of these top investors and our experienced senior management team we're moving quickly to take advantage of this dynamic market," said John Beasley, ChemConnect CEO. "There are millions of chemical buyers and hundreds of thousands of sellers all of whom trade and purchase large quantities of chemicals. With the size of the market opportunity and the large number of buyers and sellers executing multi-million dollar transactions, we believe that ChemConnect's World Chemical Exchange will become the largest business-to-business Internet exchange in the world."

ChemConnect is using the money raised to further develop and market the exchange and to expand company operations worldwide.

As can be seen from a review of the entirety of the relevant portion of the cited reference, there is no indication in the Press Release of 1999 that the system is configured to allow member businesses to directly interface their existing infrastructure directly to the World Chemical Exchange and that the World Chemical Exchange is configured to translate between the message formats that the two parties to a transaction may use. Nor is there any recognition in the reference of any need for such a system. Hence, the translation element is a feature of Claim 1 not anticipated by the Press Release of 1999. For at least this reason, Claim 1 is not anticipated by the Press Release.

Claims 2-10 depend from Claim 1, and therefore include all of the limitations of Claim 1 as well as additional limitations of particular utility. Since the Press Release of 1999 fails to disclose all of the limitations of Claim 1, it fails to disclose all of the limitations of Claims 2-10 as well for similar reasons.

With respect to 103(a) (obviousness), the Applicant respectfully submits that the generic disclosures in the Press Release fail to render the limitations in Claim 1-10 obvious for reasons

Appl. No. : 09/493,794
Filed : January 28, 2000

similar to those discussed above in relation to 102(a). Not only does the asserted Press Release fail to teach or suggest each and every recited limitation, but no secondary reference nor common knowledge in the art teaches or suggests the recited limitations for a system for facilitating chemical supplier transactions.

Therefore, Claims 1-10 are patentable over the Press Release, and Applicant respectfully requests that these claims be passed to allowance.

37 C.F.R. § 1.131

Applicant's representative continues efforts to obtain the affidavit necessary to proceed under 37 C.F.R. § 1.131 and anticipates ultimate success in obtaining and filing such an affidavit. Regardless, however, the Examiner has not made out a *prima facie* case of anticipation or obviousness. As discussed above, there is no teaching or suggestion in the art of a translation server. For this reason alone, the Examiner has not made a *prima facie* case, and Applicant requests that Claims 1-10 be passed to allowance.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 23, 2007

By: Adeel Syed Akhtar
Adeel S. Akhtar
Registration No. 41,394
Attorney of Record
Customer No. 20,995
(415) 954-4114

3698778_1
042607